suggested. Thus, there would be no motivation for one of ordinary skill in the art at the time of the invention to modify the disclosure in the Persello reference to produce the silica of the claimed invention.

A proper analysis under Section 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. *In re* Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

It is now well established by the Federal Circuit that cited prior art must provide one of ordinary skill in the art with the motivation to use the disclosure of a reference in a manner that renders the claims obvious; namely, there must be some teaching suggestion or incentive in the prior art disclosure that supports the rejection. This requirement stands as the critical safeguard against hindsight analysis and rote application of the legal test for obviousness. See, in particular, *In re* Rouffet, 47 USPQ 2d 1453, 1458 (Fed. Cir. 1998). Further, see, *In re* Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988), wherein the Court found that "The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art ... Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." In *Ex parte* Haymond, 41 USPQ 2d 1217 (Bd. of Appeals 1996) the Court found that it is impermissible to use the claimed invention as an instruction manual or "template" in order to render the claimed invention obvious.

Based on the legal authority recited above, the Persello patent does not disclose the requisite "...teaching suggestion or incentive..." nor does the patent disclose the "suggestion and the expectation of success" to support modifying the method and composition taught in Persello to produce the claimed invention. Such modification would require impermissible hindsight, thus rendering the rejection improper.

Applicants submit that in view of the above remarks, the claimed invention would not have been obvious to one of ordinary skill in the art at the time. Further, without impermissible hindsight reconstruction, there would be no motivation for one of ordinary skill to modify the teaching of Persello to produce the claimed invention. Moreover, the claimed invention is not even remotely suggested by the Persello reference. Thus, Applicants submit that claims 1-35 are in condition for allowance and Applicants respectfully request reconsideration of the claims.

Carol A. Marmo
Registration No. 39,761
Attorney of Record

Carol A Marmo

(412) 434-3797

February 28, 2003
Pittsburgh, Pennsylvania